

## **REMARKS**

Claims 1 - 5 are pending in the present application.

This Amendment is in response to the Office Action mailed August 12, 2008. In the Office Action, the Examiner rejected claims 1 - 5 under 35 U.S.C. §102(b).

Applicant has amended claims 1, 2, and 4.

### **I. REJECTIONS UNDER 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1 - 5 under 35 U.S.C. § 102(b) as being anticipated by JP 11-283283. Claims 1, 2 and 4 are the pending independent claims. Applicant respectfully traverses the rejections for the following reasons.

The JP 11-283283 reference discloses a production of master disk for producing recording medium, master disk for producing recording medium, substrate for recording medium, and recording medium.

Regarding claim 1, JP 11-283283 does not disclose a method for recording a recording track and a pit positioned between recording tracks that comprise the steps of recording the recording track and the pit by sequentially deflecting a single beam in a radius direction of a disc and a tangential direction of the disc while rotating the disc.

Regarding claim 2, JP 11-283283 does not disclose a method for recording a recording track and a pit positioned between recording tracks comprising the steps of rotating a disc; recording the recording track by irradiating a beam onto the disc; deflecting the beam in a radial direction to a position where a pit is to be formed when the beam reaches a predetermined position on the disc; recording the pit by irradiating the beam on the disc; deflecting the beam in a tangential direction; and deflecting the beam back to the position of the disc where the deflection from the recording of the recording track to the recording of the pit takes place when the beam reaches a predetermined position on the disc.

Regarding claim 4, JP 11-283283 does not disclose an information recording apparatus including a rotation driving unit for supporting and rotating a disc, a movement driving unit for moving the rotation driving unit in a radius direction of the disc, and a beam irradiating means for irradiating a single beam onto the disc so as to be freely deflectable, the information recording apparatus comprising a deflection signal generating means for

generating a radius direction deflection signal for deflecting the single beam to the radius direction of the disc and a tangential direction deflection signal for deflecting the single beam to a tangential direction of the disc; and a beam deflecting unit for deflecting the single beam on the basis of the radius direction deflection signal and the tangential direction deflection signal to record the track and the pit between tracks on the disc using the single beam deflected in the radial and tangential directions while rotating the disc.

To support a 102 rejection, the Examiner must show that “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bro. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987), (MPEP §2131). In addition, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), (MPEP §2131).

Since the identical invention is not disclosed in as complete detail as contained in claims 1, 2 and 4, those claims are patentable over the cited reference. For the same reasons, claim 3, that depends from claim 1, and claim 5, that depend from claim 4, are also patentable over the cited reference.

## **II. REJECTIONS UNDER 35 U.S.C. §102(b) AND 35 U.S.C. §103(a)**

### **A. Rejection of Claims 1, 2, and 4 over U.S. Patent No. 6,482,493**

The Examiner rejected claims 1, 2, and 4 under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,482,493 issued to Kim.

Kim discloses an optical disc with a pit wherein the width of the pit is larger than the length of the pit so that the optical disc is high in recording density. The Examiner asserts that Kim teaches the ability of having the beam deflected in order for the recording of multiple tracks. Applicant respectfully traverses the rejections for the following reasons.

Kim, taken alone or in any combination with any other cited reference, do not disclose, suggest, or render obvious the invention recited in claims 1, 2 and 4. Kim

requires multiple passes over a single track in order to create a pit width larger than the pit length. There is no disclosure in Kim of the Applicant's invention as recited in claims 1, 2, and 4.

**B. Rejection of Claims 3 and 5 over U.S. Patent Nos. 6,985,425 or 7,359,305**

The Examiner rejected claims 3 and 5 under 35 U.S.C. §103(a) as being unpatentable over the art as applied to claims 1, 2, and 4, and further in view of either U.S. Patent Nos. 6,985,425 or 7,359,305 issued to Tsukuda et al. for teaching the use of an electron beam.

The Applicant respectfully traverses this rejection since the primary reference of Kim does not disclose or render obvious claims 1, 2, and 4, it follows then that the combination of Kim with either Tsukuda et al. reference cannot disclose or otherwise render obvious claims 3 and 5.

Therefore, Applicant respectfully requests the rejections under 35 U.S.C. § 102(b) and § 103(a) be withdrawn.

**III. COPENDING U.S. APPLICATIONS**

In complying with the duty of disclosure set forth in 37 CFR 1.56, Applicant wishes to inform the Examiner that copending U.S. Application No. 10/593,476 is directed to subject material related to that disclosed in this Application.

**CONCLUSION**

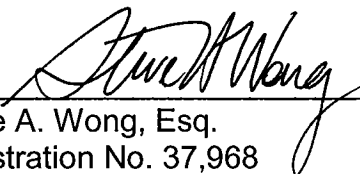
In view of the amendments and remarks made above, it is respectfully submitted that the pending claims are in condition for allowance, and such action is respectfully solicited. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to contact the undersigned attorney at the number listed below.

The Commissioner is hereby authorized to charge payment of any required fees associated with this Communication or credit any overpayment to Deposit Account No. 04-1175.

Respectfully submitted,

PIONEER NORTH AMERICA, INC.

Dated: Sept. 11, 2008

  
\_\_\_\_\_  
Steve A. Wong, Esq.  
Registration No. 37,968

PIONEER NORTH AMERICA, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
2265 E. 220<sup>th</sup> Street  
Long Beach, CA 90810  
(310) 952-3300